IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8/fm
08.14.99

ATTY.'S DOCKET: KATO=15

In re Application of:	)	Art Unit: 1761
Yukihisa KATO et al	)	Examiner: C. Sherrer
Appln. No.: 09/144,851	)	Washington, D.C.
Filed: September 1, 1998	)	August 11, 1999
For: FRUIT VINEGAR FROM RAW MATERIAL ...	)	

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

The Office Action of July 23, 1999, Paper No. 7, in the nature of a restriction requirement, has been received. Reconsideration and examination of all the claims on the merits are respectfully requested.

Applicants have made a claim for priority and have presented certified copies of the two Japanese priority applications. These were filed on December 3, 1998. Acknowledgement by the PTO of the receipt of applicants' papers filed under §119 would be appreciated.

Restriction has been required between what the PTO deems to be two patentably distinct inventions as outlined at the top of numbered page 2 of the Office Action of July 23, 1999. In reply thereto, applicants hereby respectfully and

provisionally elect Group I, presently claims 1-10 and 12-19, without prejudice and **with traverse**.

The Group II claims 11 and 20 are only product-by-process claims. With the greatest respect, it makes no sense whatsoever to restrict a product claimed in product-by-process format (especially when in dependent form as in the present case) from the process by which it is made. While applicants make no concession in this regard, certainly if the PTO were to find applicants' process in the prior art, the product made by that process as called for in claims 11 and 20 would clearly be rejected as inherently produced by such process. Therefore, it cannot be seen how the PTO can take the position that the product-by-process claims are patentably distinct from the process claims. Respectfully, this restriction requirement is not justified.

The PTO says that "the product as claimed can be made by another and materially different process", but applicants do not see how this can possibly be accurate. The product "as claimed" must be made by the process, because that is precisely what the product claims state, i.e. they are product-by-process claims. Such claims are normally interpreted by the courts, as to their scope of coverage, as being limited to the process. Therefore, the product "as claimed" cannot be made by another process, let alone one which is "**materially** different".

Furthermore, the second paragraph of MPEP §803 requires examiners to examine plural groups if it would not be a serious burden to do so, even if the restriction requirement is

otherwise correct. Under the present circumstances where the product is defined as being made by the process, it should not constitute a "serious burden" to examine the Group II claims 11 and 20 along with the process claims.

Accordingly, withdrawal of the restriction requirement and examination of all the claims on the merits are respectfully requested.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By _____
Sheridan Neimark
Registration No. 20,520

SN:rd
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
itt3\sn\kato15.rst